

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance or into better condition for appeal.

This invention provides for, *inter alia*, herbicidal compositions comprising herbicidal compounds of formula(I) and specific surfactants that exhibit a particularly potent herbicidal action.

Pursuant to 37 C.F.R. 1.17(a) and 1.136(a), a one-month extension of time, i.e. up to and including April 30, 2004, is respectfully requested. Enclosed herewith is a check for \$110.00 in payment of the fee thereof. Any deficiency or overpayment in this fee, or any other charge occasioned by this paper, may be charged or credited to Deposit Account No. 50-0320.

This amendment amends claims 2, 8, 9 and 12, cancels claims 3, 4, 5, 6, 7, 11 and 16 and adds claim 17 without prejudice admission, surrender of subject matter or intention of creating estoppel as to equivalents. The new claim 17 finds support in the previously cancelled claim 1 and in the specification. Thus, no new matter is added.

Claim 11 stands rejected under 35 U.S.C. §101 for not being a statutory claim. In view of the cancellation of claim 11, this rejection is moot and should be withdrawn.

Claims 2-4, 8-13 stand rejected under 35 USC § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the amendments to the claim 8, which removes the phrase "which is different from the compound of formula (I)", cancellation of claims 3 and 4, which recite both the broad and the narrow recitation of Z, and cancellation of non statutory claim 11, reconsideration and withdrawal of Section 112, second paragraph

rejection is requested. As these changes are formal in nature and do not affect the scope of the claims, the doctrine of equivalence is not affected.

Claims 3, 4, 9-12 were rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Roberts et al. (US 5,650,533, "Roberts"), claims 2, 8, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Roberts as applied to claims 3, 4, 9-12, 16 in view of Lewis et al. (US. 6,133,217, "Lewis") and claims 2, 8, 12 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roberts as applied to claims 3, 4, 9-12 above in view of Agbaje et al. (U.S. 6,451,731). Applicants respectfully urge that in light of cancellation of independent claim 3, rejection under Section 102 over Roberts is moot. Nevertheless, neither Roberts, Lewis nor Agbaje teach, enable, suggest or motivate a skilled artisan to practice the instantly claimed invention.

The Office Action asserts that Roberts teaches a method of applying a herbicidal composition comprising a 4-substituted isoxazole compound of formula I where R1= cycopropyl, R=H, n=3, R2=fluoro, bromo, methylsulfinyl, V=V1, and Z=Z1 to crops in order to control weed growth. Applicants respectfully disagree. Although the instant elected species is a species of the genus listed as a part of the long list of herbicidal combinations in Roberts, the Examiner is respectfully reminded that a species (or subgenus) may be patentably distinct from a genus. *See e.g., In re Baird*, 29 U.S.P.Q.2d 1550, 1551 (Fed. Cir. 1994)

Moreover, the Examiner is reminded that one may look to the preferred embodiments to determine which compounds can be anticipated. *See e.g., In re Petering*, 301 F2d. 676, 133 USPQ 272 (CCPA 1962). The Applicants urge that the preferred embodiments of Roberts provide no teaching of using 4-substituted isoxazole compound of formula (I) to control growth of harmful plants in crops and do not mention that the instant combination exhibits synergistic

results. Thus, Roberts provides only generic teaching but no exemplification or reasonable expectation of success for using instant elected species for control of harmful plants in crops. Thus, Robert cannot anticipate the present claims and the rejection must be withdrawn as a matter of law.

The Office Action further asserts that Roberts taken together with Lewis or Agbaje suggest the instantly claimed herbicidal compositions. Applicants respectfully disagree. Neither Roberts, Lewis or Agbaje taken alone or in any fair combination suggest a skilled artisan herbicidal compositions wherein the EO/PO block copolymer is used as means for enhancing activity of the herbicidal composition.

The rejection acknowledges that Roberts does not teach EO/PO block copolymers (Office Action page 4). In order to correct this deficiency, the rejection relies upon Lewis which "teaches a herbicidal composition comprising instant EO/PO block copolymer where R-alpha and R-gamma equals OH and H, respectively". Id. The rejection then concedes that "it would be obvious to one having ordinary skill in the art to modify the invention taught by Roberts to include the surfactant taught by Lewis". Applicants respectfully disagree. Lewis teaches that certain ethylene oxide/propylene oxide block polymers will effectively enhance the solubility of low 2-phenyl linear alkylbenzene sulfonate surfactants in aqueous solution (c.11, l. 11-15). Lewis is completely silent with respect to herbicidal composition. Hence Lewis provides absolutely no motivation for one of ordinary skill in the art to extrapolate the use of EO/PO block polymers in herbicidal compositions as the means for enhancing activity of the herbicidal composition. Therefore, the rejection must fail.

Office Action asserts that Lewis taken with Agbaje suggests a herbicidal composition comprising instant EO/PO block copolymer where R-alpha and R-gamma equals OH and H,

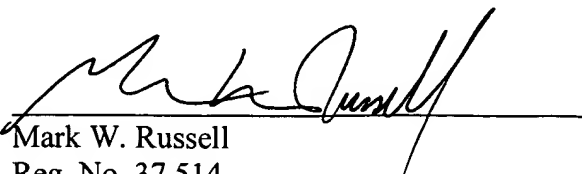
respectively. Again, Applicants respectfully disagree and suggest that Lewis taken with Abbaje in any fair combination does not suggest the present invention. The rejection states that it would have been obvious to one having ordinary skill in the art to modify the invention taught by Roberts to include the surfactant taught by Agbaje. Applicants respectfully disagree. Agbaje's goal is to teach the making and use of concentrated pesticidal compositions. Agbaje does not suggest to one skilled in the art that the activity of herbicides can be enhanced by mixing or applying herbicides with auxiliaries, such as for example, ethylene oxide/propylene oxide block polymers. Hence, rejection does not provide requisite motivation and it must fail.

As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Against this background, the instant rejections based on Roberts in view of Lewis and Agbaje must be withdrawn as a matter of law.

In view of the foregoing, reconsideration and withdrawal of the rejections are requested and favorable action is earnestly solicited.

Respectfully submitted,
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